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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,315	03/29/2001	Motoharu Akiyama	OPS Case 527	2264

7590

02/14/2003

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EXAMINER

HOWARD, JACQUELINE V

ART UNIT

PAPER NUMBER

1764

DATE MAILED: 02/14/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,315

Applicant(s)

AKIYAMA, MOTOHARU

Examiner

Jacqueline V. Howard

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1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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Claims 1 to 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuzaki et al (5,958,850) or Pillon et al (5,227,082) for the reasons of record as fully set forth in the Office Action dated July 2, 2002.

Applicant's arguments filed November 13, 2002 have been fully considered but they are not persuasive.

Applicant alleges patentability over Matsuzaki on the basis that it has no specific disclosure of a poly α -olefin being contained therein or a synthetic hydrocarbon oil having the claimed kinematic viscosity. This argument is not well taken, the disclosure at col. 2 lines 65 to 67 and col. 3 lines 54 to 58 certainly suggest a synthetic hydrocarbon oil having the claimed kinematic viscosity as well as poly α -olefins. The examiner notes that only one of the five rejected claims recite poly α -olefin as the synthetic oil.

Applicant alleges patentability over Pillon et al on the basis that there is no disclosure in this reference regarding the composition being applied to a molded plastic product and the effects associated therewith. It is the examiner's position that the rejected claims are drawn to a composition not a method of use. Patents are not granted for old composition based on their intended use.

Claims 6 to 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 6,0031598.

The Japanese reference teaches a grease composition for lubricating plastic ball seats comprising a synthetic poly-alpha olefin oil having a kinematic viscosity of 500 mm²/s at 40⁰C, a urea thickener and an amide wax rust inhibitor.

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Applicant amended the claims to recite the lubricant composition was an oil composition and alleges patentability over the Japanese reference on the basis that the reference teaches a grease which does not have the same effect on plastics as oils. The examiner takes the position that the skilled lubricant chemist recognizes a grease is an oil composition that has been thickened with a thickening agent. The omission of a substance with the concomitant loss of its function is not unobvious. It would have been obvious to one ordinary skill in the art to omit the urea thickener from the synthetic oil, rust inhibitor composition when its function was not desired. The claimed invention would not be patentable over the Japanese reference absent a showing of unexpected results flowing from such omission. (In re Wilson 153 USPQ 740).

Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to J. V. Howard at telephone number (703) 308-2514.

J. V. Howard/mn
February 6, 2003

A handwritten signature in cursive script, appearing to read "Howard", followed by a circled number "6".

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